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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,539	07/24/2003	Toshihiro Ise	Q76566	8202
23373	7590	01/18/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			YAMNITZKY, MARIE ROSE	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/625,539	ISE ET AL.
	Examiner Marie R. Yamnitzky	Art Unit 1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 November 2005.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4, 6-10, 12, 13 and 15-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 10, 12, 13 and 15-20 is/are allowed.  
 6) Claim(s) 1-4 and 6-9 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment filed on November 16, 2005, which amends claims 1, 3, 6, 10 and 15, and cancels claims 5 and 14, has been entered.

Claims 1-4, 6-10, 12, 13 and 15-20 are pending.

2. The rejection of claims 14 and 15 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, as set forth in the Office action mailed August 16, 2005, is partly rendered moot by claim cancellation and otherwise overcome by the amendment filed November 16, 2005.

The rejection of claims 10 and 12-20 under 35 U.S.C. 103(a) as unpatentable over Yanagi et al. (US 6,440,586 B1) is partly rendered moot by claim cancellation and otherwise withdrawn in view of the statement of common ownership set forth in the remarks accompanying the November 16<sup>th</sup> amendment.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2 and 6-9 stand rejected under 35 U.S.C. 102(e) as being anticipated by Nii et al. (US 6,379,823 B1) for reasons of record in the Office action mailed March 17, 2005.

Subsequent to the March 17<sup>th</sup> Office action, independent claim 1 was first amended to limit L<sub>1</sub> to the limitations set forth in original claim 5. Independent claim 1 has now been further amended to limit the divalent-heterocyclic group possibility for L<sub>1</sub> to a divalent aromatic heterocyclic group. Nii's compound represented by formula 2-20 is a compound of present formula (IA) wherein L<sub>1</sub> represents a divalent aromatic heterocyclic group.

5. Claims 1-4 and 6-9 stand rejected under 35 U.S.C. 102(e) as being anticipated by Yanagi et al. (US 6,440,586 B1) for reasons of record in the Office action mailed March 17, 2005.

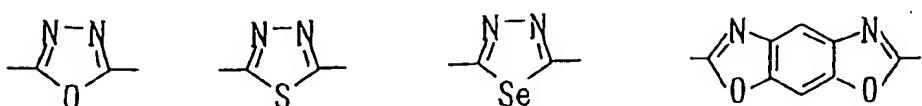
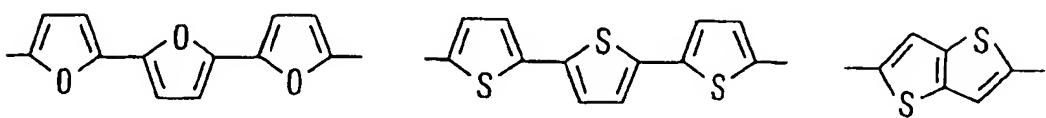
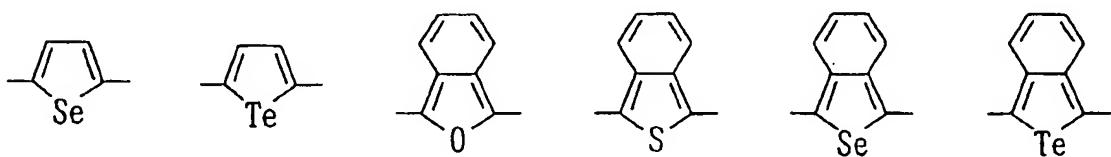
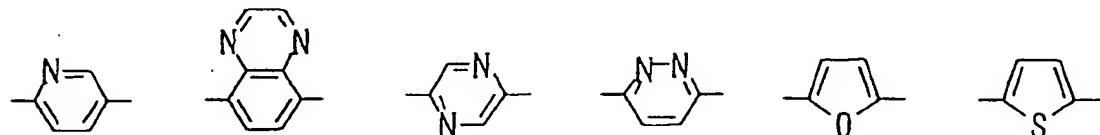
Subsequent to the March 17<sup>th</sup> Office action, independent claim 1 was first amended to limit L<sub>1</sub> to the limitations set forth in original claim 5. Independent claim 1 has now been further amended to limit the divalent-heterocyclic group possibility for L<sub>1</sub> to a divalent aromatic heterocyclic group. Yanagi's compounds represented by formula A-3 and A-23-A-27 are examples of compounds of present formula (IA) wherein L<sub>1</sub> represents a divalent aromatic heterocyclic group.

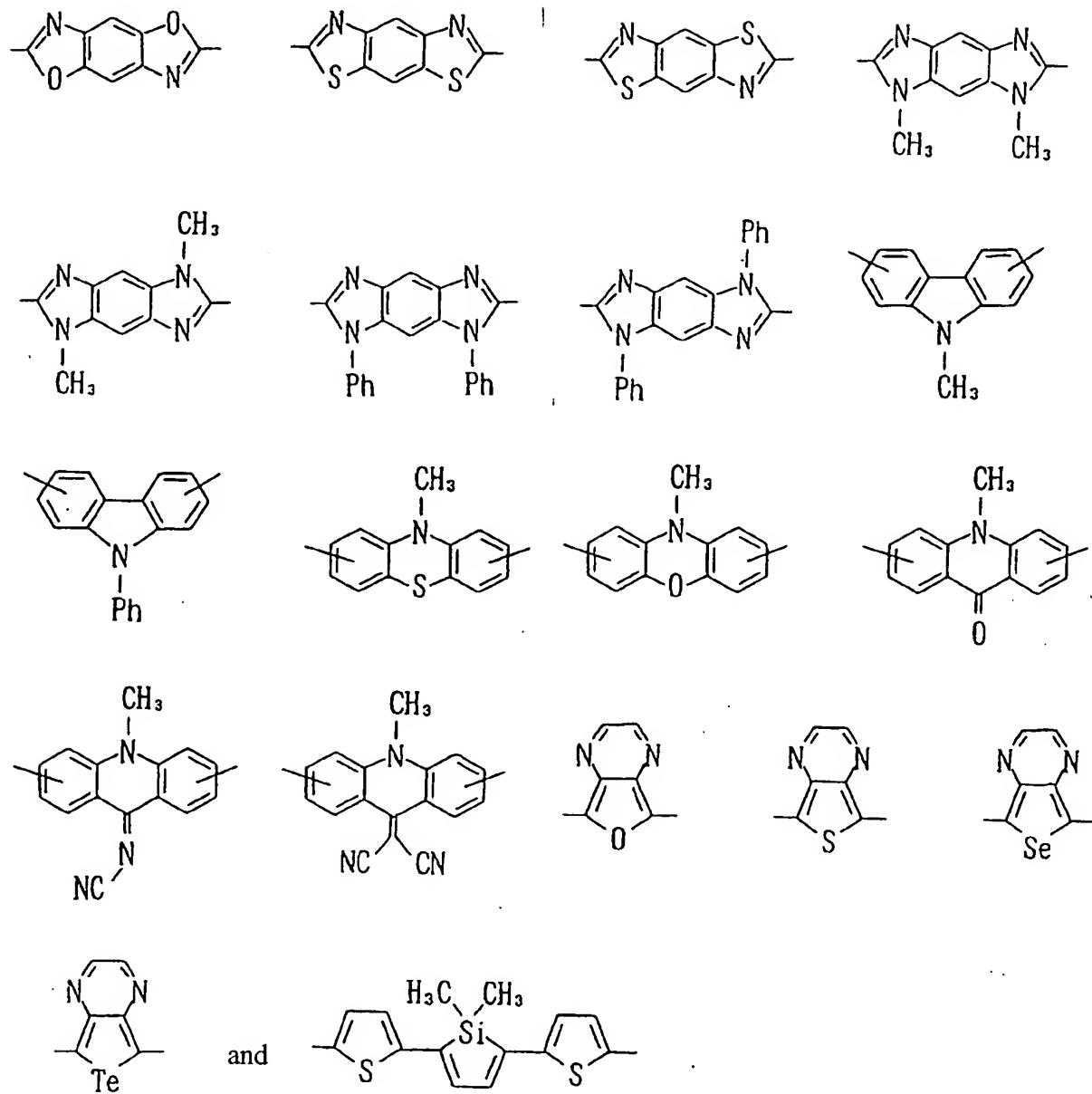
6. Applicant's arguments filed November 16, 2005 have been fully considered but they are not persuasive with respect to the two rejections under 35 U.S.C. 102(e).

In prior Office actions, the examiner referred to Nii et al. ('823) and Yanagi et al. ('586) as disclosing compounds of present formula (IA) wherein L<sub>1</sub> represents a divalent heterocyclic group. Claim 6, which has always limited the divalent heterocyclic group to a divalent aromatic

heterocyclic group, was included in the rejection based on Nii et al. and in the rejection based on Yanagi et al. in the prior Office actions. The examiner regrets any confusion that may have been caused by not using the term “aromatic” in reference to the prior art divalent heterocyclic groups corresponding to  $L_1$ ; the prior art does meet this limitation.

7. The two prior art rejections could be overcome by deleting “divalent aromatic heterocyclic group” from claims 1 and 6 (with appropriate grammatical correction for the remaining claim text), or by limiting any divalent aromatic heterocyclic group represented by  $L_1$  to one selected from the group consisting of:





(The formulae set forth above in the suggested Markush group are supported by pages 27-31 of the specification.)

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8. Claims 10, 12, 13 and 15-20 are allowed.

9. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 6:30 a.m. to 4:00 p.m. Monday, Tuesday, Thursday and Friday, and every other Wednesday from 6:30 a.m. to 3:00 p.m.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY  
January 17, 2006



MARIE YAMNITZKY  
PRIMARY EXAMINER

